

REMARKS

The application has been amended and is believed to be in condition for allowance.

There are no formal matters pending.

Amendments to the Disclosure

Independent claims 1, 14 and 18 are amended to more clearly recite the distinctive features of the invention. Dependent claims 2-6, 9, 16-17, and 19-20 are amended to address formal matters and antecedent basis issues in view of the amendments to the independent claims. New dependent claims 21-23 further claim distinctive features of the invention. The amendments find support in the specification and the drawing figures as originally filed (e.g., Figures 1-5) and do not introduce new matter.

It is further believed that the amended claims and new claims are all directed to the elected Group I, drawn to a bag with an elastic strip as elected in the response filed April 19, 2010.

Substantive Issues - Sections 102 and 103

The Official Action rejected claims 1, 2, 4-8, 10, and 14-20 under 35 U.S.C. 103(a) as being unpatentable over Malaspina (US Patent No. 6,585,415; "MALASPINA") in view of Midgley et al. (US Patent No. 5,120,138; hereinafter MIDGLEY).

The Official Action rejected claim 3 under 35 U.S.C. 103(a) as being unpatentable over MALASPINA and MIDGLEY as

applied to claims 1 and 2, and further in view of McGlew et al. (US Patent No. 6,164,824; "MCGLEW").

The Official Action rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over MALASPINA and MIDGLEY as applied to claims 1, and further in view of Raterman (US Patent No. 6,921,202; "RATERMAN").

In response, it is firstly noted that the claims have been amended, as indicated above. It is respectfully submitted that none of the references applied by the Official Action, whether considered individually or in combination, teach or suggest all the features recited in the independent claims as amended herein.

The Official Action offers MALASPINA as teaching an elastic band welded to two faces of a bag along lateral edges. However, the Official Action concedes that MALASPINA does not expressly disclose said elastic band is further welded to the bag at an intermediate connection region, the intermediate connection region forming one of the two connection regions and being at a location spaced from the two lateral edges. The Official Action offers MIDGLEY as teaching that welding an elastic band to a bag at end points only, continuously along the length, or intermittently are equivalents, and thus contends that it would have been obvious to a person having ordinary skill in the art to attach the elastic band taught by MALASPINA intermittently instead of solely at the ends.

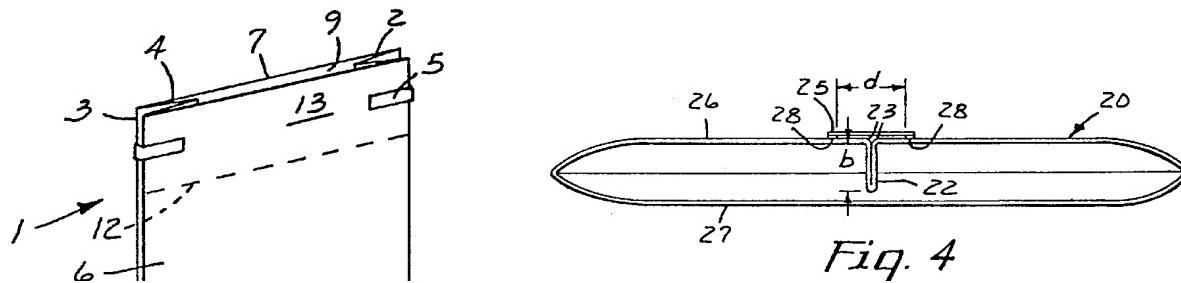
However, neither of MALASPINA or MIDGLEY, individually or in combination, teach or suggest the elastic band of the invention, joined to a face of the bag as recited in the claims such that a length L2 of the elastic band is free of adhesion to the face. MALASPINA and MIDGLEY further fail to teach that the length L2 of the elastic band has an elasticity sufficient to, when the rim of the bag is positioned over the peripheral edge of the container, i) stretch over the opening to a position on an opposite second face of the bag and ii) exert a an elastic force sufficient to hold the rim onto the peripheral edge of the container.

On the contrary, the combination of MALASPINA and MIDGLEY, at best, leads to an elastic band with a plurality of welds along a periphery of the bag, as shown in MIDGLEY Figure 7. There is no teaching or suggestion in MIDGLEY of any length of elastic band between any two welds sufficient to i) stretch over the opening of the bag to a position on a second of the two faces and ii) exert an elastic force sufficient to hold the rim of the bag onto a peripheral edge of a container.

Instead, MIDGLEY teaches an entirely different application of elastic force. Rather than stretching a length of elastic over an opening of the bag to an opposite second face, MIDGLEY teaches welding opposite ends of relatively short elastic bands to opposite ends of gusset folds thereby

to resiliently maintain these folds so that the rim of the bag tends to close. MIDGLEY does not teach or even suggest any manipulation of these elastics other than resiliently stretching them to the extent of the gusset folds to which they are attached (see, e.g., column 3, lines 30-36 and 52-60; column 4, lines 46-55).

Examples of MIDGLEY's gusset arrangement as shown in Figures 1 and 4, showing gussets 2,22 and elastics 5,25 are provided below for the Examiner's convenience.



One of skill would have understood that the elastic qualities of the elastic band(s) taught by MIDGLEY would not require stretching far beyond the extent to which the gussets unfold.

This is in stark contrast to the elastic band recited in the independent claims, and also contrasts sharply with the long elastic band of MALASPINA which must stretch twice around the peripheral edge of a container (see MALASPINA Figures 6 and 7). Applicant respectfully maintains that MALASPINA and MIDGLEY are not reasonably combinable for at least this reason.

Further, neither MALASPINA or MIDGLEY, whether considered individually or in combination, teach or even suggest the arrangement of the joinings of the elastic band to the face of the bag, as recited by the amended independent claims. Particularly as none of these references suggest the operation of the claimed elastic for holding the inventive bag to a container, none of these references teach any structure that would have led the skilled person to the claimed invention.

It is further respectfully submitted that MCGLEW makes no teaching or suggestion to overcome the deficiencies of MALASPINA and MIDGLEY. Therefore, it is respectfully submitted that the independent claims, as amended, are patentable.

It is further respectfully submitted that the claims depending from independent claims 1, 14 and 18 are patentable at least for depending respectively from patentable parent claims.

For example, it is respectfully submitted that claims 10 and 15 are patentable in their own right, in addition to being dependent respectively from claims 1 and 14.

The Official Action apparently contends that the elastic degree is a result effective variable, and therefore concludes that it would have been obvious to the skilled person to have made the elastic with whatever degree of elongation is desired.

In response, it is respectfully submitted that the Official Action has not provided evidence that the elastic

degree is a result effective variable known to the skilled person at the time of the invention.

It is further respectfully submitted that MALASPINA teaches away from the elastic properties recited in claims 10 and 15. In order for the elastic band to function as shown in Figures 6 and 7, MALASPINA discloses "The degree of elastic stretch should be higher than 200%, say about 250%, and preferably 300% or more, without reaching the yield point, so that the elastic springback of the ribbon will tighten the overturn of the bag around the bin," (column 3, lines 15-19). "The elastically extensible ribbon is preferably also made of polyethylene, which, however, must be a mix having a high degree of elastic stretch," (column 3, lines 13-15).

Similarly, MIDGLEY also teaches elastic properties far greater than that of claims 10 and 15 (see, e.g., column 8, lines 15-30).

It is therefore respectfully submitted that claims 10 and 15 are patentable in their own right, in addition to being respectively dependent from patentable parent claims.

Further, it is also respectfully submitted claim 3 is patentable in its own right, in addition to being dependent from claim 1.

As to claim 3, the Official Action concedes that the foregoing combination fails to teach a hem with a skirt

extending beyond it, the elastic band being joined to a face of the bag by overlapping the skirt at least partially.

The Official Action offers MCGLEW for placing an elastic band in the extension or skirt of a fold forming a hem in the top of the bag is an *equivalent alternative* to placing both in the same hem, as taught by MALASPINA, and therefore contends that it would have been obvious to one of ordinary skill in the art to substitute the double hem/skirt structure taught by MCGLEW for the single hem structure taught by MALASPINA as modified by MIDGLEY in view of MCGLEW's teaching of equivalence.

However, it is respectfully submitted that MCGLEW fails to teach that for which it is offered. That, is MCGLEW fails to teach a skirt extending beyond a hem.

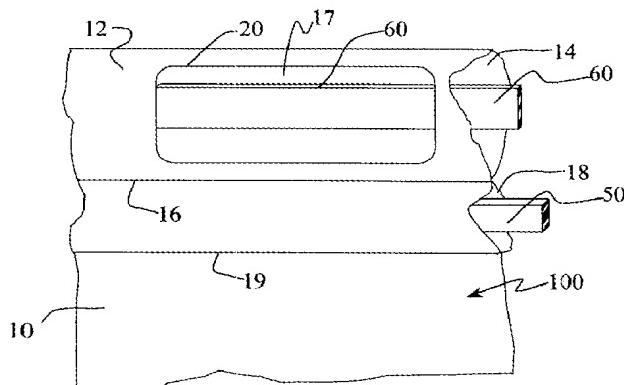


Fig. 3

On the contrary, as shown in Figure 3 provided above, MCGLEW merely teaches another hem that is welded to the sheet at 19. This structure does not teach a skirt, as recited by the amended independent claims.

Further, the conclusion of obviousness is not sufficient merely because the references relied upon allegedly teach that substantially all aspects of the claimed invention were individually known in the art; an objective reason to combine the teachings of the references must be articulated with some rational underpinning to support the legal conclusion of obviousness. MPEP § 2143.01, paragraph IV.

The Official Action seems to argue that MCGLEW would have taught one of skill in the art that placing an elastic band 50 in a separate hem in the top of the bag is *interchangeable* with placing both an elastic band 50 and an inextensible cinch element 60 in the same hem. However, even if this were true, the Official Action offers no explanation why these placements of the elastic band are *interchangeable* with respect to MALASPINA.

It is respectfully submitted that these structures are not interchangeable with MALASPINA. The elastic element discussed by MCGLEW, particularly in the embodiment where it is enclosed within its own hem, is only meant to stretch once around the edge of a trash can (see column 3, lines 47-57; column 4, lines 20-23; Figure 1). Thus, there is no need for the user to grasp the elastic band itself and draw it out of the hem. Accordingly, MCGLEW discloses no opening in the hem 18 to grasp the elastic band.

In stark contrast, MALASPINA is directed to a device where the elastic band 46 is far more loose so that it may be drawn out from the hem and wrapped twice around the can to secure the bag to the can (see Figures 6 and 7). MCGLEW does not teach a second hem 18, spaced further from the edge of the bag than the first hem 14, having any opening for drawing out the elastic band.

Therefore, it is respectfully submitted that the applied references also fail to teach the claimed features claim 3.

Withdrawal of the rejections under Section 103 is respectfully requested.

From the foregoing, it will be apparent that Applicant has fully responded to the December 23, 2010 Official Action and that the claims as presented are patentable. In view of this, Applicant respectfully requests reconsideration of the claims, as presented, and their early passage to issue.

In order to expedite the prosecution of this case, the Examiner is invited to telephone the attorney for Applicant at the number provided below if the Examiner is of the opinion that further discussion of this case would be helpful in advancing prosecution.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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